

Application No. 10/634,474
Docket No. 1999U026.US-CON2
Reply to Office Action Dated April 26, 2004

Remarks

Claim Amendments

Claim 1 is further amended to conform the claim language to the previous amendments, by deleting the phrase "L' is a Group 15 or 16 element or Group 14 containing group;". Claim 4 is also amended to remove the term "L'," The Applicant thanks the Examiner for pointing out these errors, and requests that this rejection be withdrawn.

Also, Claim 20 is amended to insert the term "mole" to reflect the -mole ratio-, as disclosed in the patent application as filed.

Section 112, ¶ 1 Rejections

The Examiner rejected the claims under 35 U.S.C. § 112, ¶ 1 as not being enabled for the subject matter claimed. The Applicant respectfully traverses, as it is believed that the Applicant has demonstrated possession of the claimed embodiment and has claimed the invention commensurate in scope with such possession.

First, the Applicant clearly states in the specification as filed at page 25, lines 2-3 (¶ 0110): "Altering the polymerization temperature can also be used as a tool to alter the final polymer product properties". Other statements support the Applicant's claimed embodiment such as at page 48, ¶ 0184.

Second, the working Examples demonstrate the claimed embodiment of invention. As summarized in Table 1, Example 3 was performed at 80°C, while Examples 4, 5 and 6 were performed at 85°C. As the Table 1 shows, most all other parameters of the polymerization process are constant between the Example 3 and Examples 4, 5 and 6. The increase in temperature demonstrates the decrease in molecular weight distribution of the polyethylene generated therefrom from the value of 43 (at 80°C) to 24.2, 24.1 and 25.4 (at 85°C). Example 7 shows a similar trend, but the C₆/C₂ mole ratio is different in that example, exemplifying yet another embodiment of the invention.

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The Applicant thus requests that this rejection be withdrawn.

Section 112, ¶ 2 Rejections

The rejection of Claims 1 and 9-15 under 35 U.S.C. § 112, ¶ 2 as indefinite is maintained, with reference to the holding in *Ex parte Slob*. The Applicant traverses this rejection by reference to the last response (1.116 After Final, 5/7/04), and by the further remarks below, as Applicant contends that the present fact situation is distinguishable from those in the claims of *Slob*, and more in line with those in *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

In *Ex parte Slob*, 157 USPQ 172 (Bd. Pat. Appl. & Int. 1967), the court rejected as indefinite a claim limitation, that limitation being the only descriptor of a component to a claimed composition. In particular, the court upheld the Examiner's rejection of the following phrase:

a liqueffable substance having a liquefaction temperature from about 40 °C. to about 300 °C. and being compatible with the ingredients in the powdered detergent composition

In upholding the Examiner's rejection of the claim, the court stated:

this language purports to cover everything which will perform the desired functions regardless of its composition, and, in effect, recites the compounds by what it is desired that they do rather than what they are. *Id.* at 173.

The court further stated:

setting forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future and which would impart the desired characteristics. *Id.* at 173 (emphasis added).

The court in *Slob* upheld the Examiner's rejection of the claims because that Applicant described the claimed "substance" only in terms of physical characteristics desired, and not specific compositions which would meet such characteristics. The court further states that such a

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phrase "read[s] upon materials that could not possibly be used"; and further, the Examiner in rejecting the phrase cited specific examples of "substances" that would fall within the objected-to-phrase but could not be used for the claimed process.

The present claims are distinct from those dealt with in *Slob*, as the current Applicant has in fact claimed "specific compositions which would meet such characteristics", along with a modifying phrase that sets forth "physical characteristics". The Applicant describes in Claim 1 the catalysts by specific terms well defined in the specification and claims, and further defines certain process parameters that any person skilled in the art of olefin polymerization would understand. The Examiner has not shown in the instant case that Claim 1 describes "substances" and/or processes that would "read upon materials that could not possibly be used" in the claimed process.

In Claims 9-15, what is claimed is a "polyethylene copolymer"—clearly derivable from the Claim 8 and Claim 1—having further defined characteristics. In fact, the court in *Slob* did not uphold the Examiner's rejection to certain narrowed dependent claims, for reasons consistent with the current Applicant's contention: that Claims 9-15 represent more narrow embodiments of the claimed invention and are well defined in light of the specification as filed and the knowledge of one skilled in the art. The Applicant, in Claims 9-15, is in fact setting forth a specific composition ("polyethylene copolymer") having certain "physical characteristics". This practice is allowable and in accord with the holding in *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971), and as discussed in the MPEP 2173.05(g) (Rev. 1 Feb. 2003).

The court in *Barr* reversed the Examiner's finding that a claim phrase was indefinite simply because it was functional. In *Barr*, the objected to claim was to a specific compound or named class of compounds, the compound further defined by the phrase "incapable of forming a dye with said oxidized developing agent". The court held that

[t]he real issue in any such case is not whether the recital is "functional" or "negative," but whether the recital sets definite boundaries on the patent protection sought - that is, whether those skilled in the relevant

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art can determine what the claim does or does not read on. Judged by this standard, we think it clear that the controverted language complies with the second paragraph of section 112. *Id.* at 595.

The *Barr* court clearly allows the use of functional features that modify chemical structures/descriptions and other process-related terms and phrases. The Applicant contends that, in light of *Barr*, the present Claims 1 and 9-15 set "definite boundaries" to one skilled in the art and thus comply with the second paragraph of Section 112. The Examiner has not shown that Claims 1 and 9-15 set indefinite boundaries or that one skilled in the art could not determine what the claims do or do not read on.

The Applicant requests the withdrawal of this rejection.

It is submitted that the case is in condition for allowance. The Applicant invites the Examiner to telephone the undersigned attorney if there are any other issues outstanding which have not been presented to the Examiner's satisfaction.

Respectfully submitted,

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Date

Kevin M. Faulkner
Kevin M. Faulkner
Attorney for Applicants
Registration No. 45,427

Univation Technologies, LLC
5555 San Felipe, Suite 1950
Houston, Texas 77056-2723
Phone: 713-892-3729
Fax: 713-892-3687